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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

LAMBERTSON, DAVID A

ART UNIT PAPER NUMBER

1636

DATE MAILED: 07/29/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/716,639

Applicant(s)

COLAVIZZA ET AL.

Examiner

David Lamberson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 20-22 and 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19, 23 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group I in Paper No. 6 is acknowledged. The traversal is on the ground(s) that the examination of the additional claims would not require an additional burdensome search. This is not found persuasive because Group I and Group II belong to distinct classes and subclasses and therefore would require additional searches based upon their individual classifications.

The requirement is still deemed proper and is therefore made FINAL.

Claims 20-22 and 25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected group, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 6.

Specification

A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

Claim Rejections - 35 USC § 112

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The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2-5, 8, 11-14 and 16-18 (and all dependent claims) are rejected under 35

U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

It is apparent that the yeast strains are required to practice the invention. As such, they must be readily available or obtainable by a repeatable method set forth in the specification, or otherwise readily available to the public. If it is not so obtainable or available, the requirements of 35 U.S.C. 112, first paragraph, may be satisfied by a deposit of the yeast strains.

The process to generate the indicated yeast strains that is disclosed in the specification does not appear to be repeatable and it does not appear the materials are readily available to the public. It is noted that the applicant has deposited the indicated strains, but there is no indication that the organism is publicly available.

If a deposit is made under the terms of the Budapest Treaty, then an affidavit or declaration by Applicants, or a statement by an attorney of record over his or her signature and registration number, stating that the instant invention will be irrevocably and without restriction released to the public upon the issuance of a patent, would satisfy the deposit requirement made herein. If a deposit has not been made under the Budapest Treaty, then in order to certify that the deposit meets the criteria set forth in 37 CFR 1.801-1.809 and MPEP 2402-2411.05, Applicant

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may provide assurance of compliance by affidavit or declaration, or by a statement by an attorney of record over his or her signature and registration number showing that:

- a) during the pendency of the application, access to the invention will be afforded to the Commissioner upon request;
- b) all restrictions upon availability to the public will be irrevocably removed upon the granting of the patent;
- c) the deposit will be maintained in a public depository for a period of 30 years, or 5 years after the last request for the enforceable life of the patent, whichever is longer;
- d) a test of the viability of the biological material at the time of deposit (see 37 CFR 1.807); and
- e) the deposit will be replaced if it should ever become inviable.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-19, 23 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Claims 1-19, 23 and 24 are rejected because the claims do not begin with an article such as "A" or "The", thereby rendering the claims indefinite.

Claims 1-15 are rejected as being indefinite because of the use of the term "new" in the description of the invention. It is presumed that any patentable material is inherently novel, therefore the use of "new" offers confusing language.

Regarding claims 1, 2 and 12 (and all dependent claims), the phrase "for example" (depicted as "i.e." in the indicated claims) renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

The term "produced conventionally" in claim 2 is a relative term which renders the claim indefinite. The term "produced conventionally" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

The term "similar" in claims 5, 8, 12, and 18 is a relative term which renders the claim indefinite. The term "similar" is not defined by the claim, the specification does not provide a

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standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

The term "good general performances" in claims 1 and 12 is a relative term which renders the claim indefinite. The term "good general performances" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

The term "bad taste" in claims 1 and 12 is a relative term which renders the claim indefinite. The term "bad taste" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

The term "off-flavors" in claims 1 and 12 is a relative term which renders the claim indefinite. The term "off-flavors" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely

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exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 2 recites the broad recitation "...higher by at least 20%...", and the claim also recites "...preferably by at least 30%..." and "...preferably by at least 40%..." which are narrower statements of the range/limitation. Furthermore, claim 2 also recites the broad recitation "...lower by at least 10%...", and the claim also recites "...by at least 15%..." and "...by at least 20%..." which are narrower statements of the range/limitation.

Claims 9-11 recite the broad recitation "...between 70% and 80%...", and the claim also recites "...between 72% and 78%..." which is a narrower statement of the range/limitation. Claim 9 further recites the narrower recitation "...between 74% and 78%...".

Claims 8 and 11 contain improper Markush terminology, using multiple conjunctions to describe the groups that are to be selected from. Proper Markush terminology contains a single conjunction following the penultimate member of the group to be selected from.

Claim 2 contains the trademark/trade name CHOPIN®. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a

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trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe an instrument designed to measure gas release and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5, 13, 16 and 18 (and all dependent claims) are rejected under 35

U.S.C. 102(b) as being anticipated by Loiez nee Hennette, et al., US Patent No. 5,741,695

(henceforth referred to as the '695 patent).

The '695 patent describes new baker's yeast strains generated by a standard method described in US patent No. 4,396,632 by Clement et al. By applicant's admission, strain L17, also known as I-2421, was originally disclosed in the '695 patent (see specification p.17, first paragraph). Although applicant indicates that I-2421 was initially "considered at that time as presenting no interest as a baker's yeast strain due to its too high invertase content," the properties of the strain as claimed were inherent to the strain, and therefore the strain in itself is not patentable. In addition, any claim in the instant application to a new baker's yeast according

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to strain I-2421 generated by using the method described in the '695 patent is anticipated by the '695 patent.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7, 8, 19 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loiez nee Hennette, et al., US Patent No. 5,741,695, in view of Clement, et al., US Patent No. 4,328,250.

The instant invention involves the use of a particular yeast strain, I-2421, and similar strains, for the production of new baker's yeast strains. The production of the new baker's yeast strains is by a standard process, containing an additional step whereby the final cultivation cycle involves a discontinuous flow of molasses.

Loiez nee Hennette, et al., teaches the use of I-2421 (as disclosed in the specification of the instant application; see p.17 of the specification) to generate new baker's yeast strains by a standard process.

Loiez nee Hennette, et al., does not teach the variation of the final cultivation step involving a discontinuous flow of molasses.

Clement et al., teaches the use of a discontinuous flow of molasses during the final cultivation cycle in the preparation of new baker's yeast strains for the purpose of generating "yeasts which perform very well on sweetened doughs whatever the sugar content...by adopting a method of discontinuously feeding the yeasts...in the last multiplication cycle, to cause the molasses which have to be introduced in a given time to flow in over a much shorter period, the flow being interrupted..." (Column 6, lines 17-22 and 55-58). The use of the discontinuous flow step also greater lowers the invertase content of yeasts (column 8, lines 18-21), which is a significant problem with baker's yeast used on sweetened doughs because of decreased osmotolerance.

Loiez nee Hennette, et al., is modified by Clement, et al., by adding the step involving the discontinuous flow of molasses to the final cultivation cycle of the yeast.

The ordinary skilled artisan, seeking to develop the claimed new baker's yeast strains and process for their preparation would have been motivated to combine the teachings of Loiez nee Hennette, et al., with respect to the use of I-2421 to generate new baker's yeast strains by a standard process with the teachings of Clement et al., on the use of a discontinuous flow of molasses during the final cultivation cycle in the preparation of new baker's yeast strains because the method of Clement, et al., teaches an advance on the standard process for the creation of baker's yeast strains for use on sweetened doughs, whereby they're invertase content is lowered and their osmotolerance is increased. Since the instant application considers the use of sweetened doughs, these characteristics would be beneficial to the invention. It would have been obvious to modify Loiez nee Hennette, et al., to use a discontinuous flow of molasses during the final cultivation cycle in the preparation of baker's yeast because this step is an advance on the

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standard process for the generation of baker's yeasts, with the intention of generating yeast with good performances on sweetened doughs, which is goal the applicant of the instant application wishes to address.

Given the teachings of the stated prior art and the level of skill of the ordinary skilled artisan at the time of the applicants' invention, it must be considered that said skilled artisan would have had a reasonable expectation of success in practicing the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A Lambertson whose telephone number is (703) 308-8365. The examiner can normally be reached on 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Irem Yucel can be reached on (703) 305-1998. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

David A. Lambertson
July 23, 2002

DAVID GUZO
PRIMARY EXAMINER
David Guzo